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REMARKS

This is a full and timely response to the non-final Official Action mailed March 15, 2005. Reconsideration of the application based on the following remarks is respectfully requested. Claims 1-3, 8, 16-19, 29-32, 37, 54-56 and 59 have been examined thus far. New claim 63 has been added by the present amendment and is also now pending for examination.

Restriction:

The Office Action correctly notes that Applicant has *not* admitted, and does not consider, that the Figs. 1-12 illustrate twelve different embodiments which all are merely obvious variants of each other and that are not patentably distinct. Rather, Applicant clearly traversed the improper Species Election of October 19, 2004 on the grounds that no explanation was provided to explain why and how each of Figs. 1-12 represents a different and patentably distinct species.

Despite Applicant's traversal of the Species Election, the current Office Action similarly fails to provide any explanation as to why the each of the figures is considered to represent a patentably distinct species. MPEP § 803 clearly states that "Examiners *must* provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases." (emphasis added). The Office has failed on the present record to provide the required "reasons and/or examples" to support the conclusion that each of claims 1-12 illustrates a patentably distinct species. Until the Office meets this burden, the Species Election imposed is improper. Consequently, Applicant continues to traverse this requirement to elect a species and requests an explanation as to why each of Figs. 1-12 represents a different and patentably distinct species.

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In reconsidering this species election, the Office may also wish to note MPEP § 806.04(f) which reads:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.
(emphasis added).

Next, the recent Office Action states that "the species of Fig. 1 does not include the features recited in the elected claims 4-7, 12-15, 20, 21, 33-36, 57, 58, 61 and 62." (Office Action of March 15, 2005). Consequently, these claims are treated as withdrawn by the Office Action. This is incorrect.

Claim 4 recites: "wherein said lens tube is configured to translate along said lens track such that said lens is vertically positioned at an angle between 0 and 180 degrees with respect to said swivel base." Fig. 1 illustrates the lens track (104) and the lens tube (103) positioned between 0 and 180 degrees with respect to the swivel base (105). Thus, it is unclear how the Office Action can allege that Fig. 1 does not illustrate the subject matter of claim 4.

Claim 5 recites "wherein said translation of said lens tube along said lens track is motorized." Fig. 1 is intended to be a pure exterior view and thus cannot expressly show the interior motor for the lens track. However, nothing about Fig. 1 excludes the possibility of a motorized lens track. Moreover, Fig. 2 is intended to be another illustration of the same device of Fig. 1, but showing relevant internal features, such as the motor (109) and détente (108), and also showing the lens tube in different position, i.e., 180 degree position with respect to the base (105), to illustrate the range of motion of the lens tube (103). Thus, it is

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again unclear how claim 5 does not read on the subject matter illustrated in Fig. 1. The same is true of claims 6, 20, 21, 33-35.

Claim 7 recites "wherein said swivel base is configured to be coupled to a ceiling." The base (105) shown in Fig. 1 has a flat surface and thus is configured to be coupled to ceiling. Therefore, it is again unclear how the Office Action can allege that Fig. 1 does not illustrate the subject matter of claim 7. The same is true of claims 36 and 57.

In light of these comments, the Office should revisit the ill-considered species election as well as the determination of which claims read on the subject matter of Fig. 1. The Office has improperly withdrawn and failed to examine claims that clearly belong with the elected species of Fig. 1.

Moreover, for the reasons explained below the generic claims in the application, including claim 1, are clearly patentable over the prior art of record. Consequently, all claims that come under those allowable generic claims should not be reintroduced and examined.

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Drawings:

The Action first objected to the drawings under 37 CFR 1.121(d) for allegedly not illustrating the light source recited in claims 8 and 37. This objection is misplaced.

The claimed light source is illustrated as element (192) in Fig. 10 and is described as such in the corresponding text of the application. Therefore, reconsideration and withdrawal of the objection to the drawings is respectfully requested.

Claim Objection:

Claim 55 was objected to for a minor inconsistency with independent claim 54. Consequently, claim 55 has been amended herein per the Examiner's suggestions and is thought to no longer be objectionable. Notice to this effect is respectfully requested. The amendment to claim 55 does not, and is not intended to, alter or narrow the scope of claim 55 in any way.

Prior Art:

With regard to the prior art, the recent Office Action rejects claims 1-3, 8, 16-19, 29-32, 37, 54-56 and 59 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 2, 168,799 to Korkosz et al. ("Korkosz"). For at least the following reasons, this rejection is respectfully traversed.

Claim 1 recites:

A projector, comprising:
a housing for housing circuitry configured to generate an image, said housing including a bottom surface;
a lens configured to focus and project said image; and
a swivel base coupled to said bottom surface of said housing;

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wherein said lens is aimed in a horizontal plane by swiveling said housing on said swivel base.

Independent claim 29 similarly recites:

A method of making a projector, said method comprising:
providing a housing for housing circuitry configured to generate an image that is then projected through a lens, said housing including a bottom surface; and
coupling a swivel base to said bottom surface of said housing.
(emphasis added).

Independent claim 54 similarly recites:

A projector, comprising:
circuitry configured to generate an image;
a lens for projecting said image;
a housing for said circuitry; and
means for rotating said housing with respect to a housing base to direct a projected image in a desired direction.

In contrast Korkosz fails to teach or suggest a housing that houses circuitry that generates an image which is then projected by a lens, as claimed. The device taught by Korkosz is a projector for a planetarium that merely generates "spots of light onto a screen or projection surface, to represent the celestial bodies such as stars and the like." (Col. 1, lines 1-6).

As shown in Fig. 2, there is no circuitry inside the housing (10) of Korkosz that produces an image that is then projected as claimed. Rather, there are merely a number of light sources (12, 14 and 16) inside the Korkosz housing. Light from these sources is emitted from numerous lenses (18) to simulate a star field. Consequently, Korkosz does not teach or suggest the claimed projector that houses circuitry for generating an image which image is then, after being generated, focused and projected through a particular, single lens as claimed.

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"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, for at least this reason, the rejection of claim 1, 29 and 54 and their respective dependent claims based on Korkosz should be reconsidered and withdrawn.

Claim 2 recites:

The projector of claim 1, further comprising:
a lens tube containing said lens;
a lens track on said housing;
wherein said lens tube is configured to translate along said lens track to vertically position said lens.
(emphasis added).

Claim 30 similarly recites: "coupling a lens track to said housing; and coupling a lens tube containing a lens to said housing and said lens track." Claim 31 goes on to recite:

"configuring said lens tube to translate along said lens track." Claim 55 similarly recites: "a vertical translation means coupled to said housing wherein said lens is disposed in a lens tube configured to move along said vertical translation means with respect to said housing."

In contrast, Korkosz does not teach or suggest a lens track *on said housing* along which a lens tube translates to vertically position the lens. Korkosz teaches a track (4) on which the entire housing (10) may move. This is not what is claimed. Korkosz does not teach the claimed lens track *on a housing* with a lens tube, not the entire housing, moving along the lens track. For at least this additional reason, the rejection of claims 2, 30, 31 and 55 should be reconsidered and withdrawn.

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Claim 8 recites "a light source separate from said lens, said light source being disposed on an exterior of said housing so as to provide light around an area of said housing."

Claim 37 similarly recites "coupling a light source to an exterior of said housing."

In contrast, Korkosz does not teach or suggest a light source disposed on an exterior of the housing as claimed. For at least this additional reason, the rejection of claims 8 and 37 should be reconsidered and withdrawn.

Claim 17 recites that the image projected "comprises a video image." In contrast, Korkosz clearly does not teach or suggest a projector that outputs video or a video image. For at least this additional reason, the rejection of claim 17 should be reconsidered and withdrawn.

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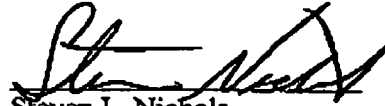
Conclusion:

Newly added claim 63 is thought to be clearly patentable over the prior art of record at least due to its dependent on allowable claim 1. Therefore, Applicant respectfully requests examination and allowance of the new claim.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: 14 June 2005


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